Supreme Court, U.S.
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961271 FEB 10 1997

No. 97-

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1996

PERRY W. GUINN, GARY N. MILLS,
ROBERT A. BEDIENT and MARTIN O. GREELEY,
Petitioners,

v.

HENRY B. KOPF,
Respondent.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

---

PETITION FOR A WRIT OF CERTIORARI

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38 pp

QUESTIONS PRESENTED

1. Is 37 C.F.R. § 1.662(c) invalid under 35 U.S.C. § 6(a) because it is "inconsistent with" 35 U.S.C. § 253?

2. In an interference declared by the Commissioner of Patents and Trademarks between a patent and a pending application pursuant to 35 U.S.C. § 135(a)

> wherein all issues of priority of invention are mooted by the patentee's statutory disclaimer under 35 U.S.C. § 253 of all of the involved patent claims

does the Board of Patent Appeals and Interferences have jurisdiction after the disclaimer to enter a judgment that the patentee is not entitled to a patent containing the claim which he had already disclaimed?

3. In an interference declared pursuant to 35 U.S.C. § 135(a) by the Commissioner of Patents and Trademarks between a patent and a pending application

> wherein all issues of priority of invention are mooted by the patentee's statutory disclaimer under 35 U.S.C. § 253 of all of the involved patent claims and
>
> wherein no issues of patentability of the involved application claims have been fully developed on the record of the interference before the Board of Patent Appeals and Interferences,

does the board have jurisdiction to hold, in the absence of a record, that the patent applicant is entitled to a patent containing the involved application claims?

LIST OF ALL PARTIES TO THE PROCEEDING IN THE FEDERAL CIRCUIT

Petitioners Guinn, Mills, Bedient and Greeley, the patentees named on U.S. patent 4,889,812 involved in the proceeding before the Court of Appeals, are nominal parties. The real party petitioner in interest is UniSyn Technologies, Inc., 25 South Street, Hopkinton, Massachusetts 01748, assignee of that patent. As to UniSyn, there is no parent company or wholly owned subsidiary.

Respondent Kopf, an individual, was a party to the proceeding in the Court of Appeals.

The Commissioner of Patent and Trademarks was not a party to the proceeding in the Court of Appeals. The Commissioner filed a brief amicus curiae urging affirmance.

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---

PETITION FOR A WRIT OF CERTIORARI

Petitioners, Perry W Guinn, Gary N. Mills, Robert A. Bedient and Martin O. Greeley ("Guinn") respectfully petition this Court for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The opinion of the Board of Patent Appeals and Interferences (App. 9a-14a) is not reported.

The opinion of the Court of Appeals for the Federal Circuit (App. 1a-8a) is reported at 96 F.3d 1419 (Fed. Cir. 1996).

JURISDICTION

The Order of the court of appeals denying a timely petition for reconsideration was filed November 12, 1996. This petition is timely under this Court's Rule 13.3.

The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1). The Court of Appeals had jurisdiction under 28 U.S.C. § 1295(a)(4)(A) (1994) and 35 U.S.C. § 141 (1994).

STATUTORY PROVISIONS, FEDERAL REGULATIONS AND TREATISE INVOLVED

Statutory Provisions:

35 U.S.C. § 6(a):

> (a) The Commissioner . . . may, subject to approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

35 U.S.C. § 135(a) (1952):

> (a) Whenever an application is made for a patent, which in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences. . . . A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent and Trademark Office.

35 U.S.C. § 135(a) (1994):

> (a) whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any

unexpired patent, an interference may be declared and the Commissioner shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability. . . .

35 U.S.C. § 253 (1952):

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim. . . .

Federal Regulations:

37 C.F.R. § 1.601(f):

(f) A *count* defines the interfering subject matter between two or more applications or between one or more applications and one or more patents. . . . A claim of a patent or application that is designated to correspond to a count and is identical to that count is said to correspond exactly to the count. A claim of a patent or application that is designated to correspond to a count but is not identical to the count is said to correspond substantially to the count. . . . [emphasis in original]

37 C.F.R. § 1.601(i):

(i) An *interference* is a proceeding instituted in the Patent and Trademark Office before the Board to determine any question of patentability and priority of invention between two or more parties claiming the same patentable invention. . . . [emphasis in original]

37 C.F.R. § 1.601(n):

(n) Invention "A" is the *same patentable invention* as an invention "B" when invention "A" is the

same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a *separate patentable invention* with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". [emphasis in original]

37 CF.R. § 1.635:

A party seeking entry of an order relating to any matter other than a matter which may be raised under §1.633 or § 1.634 may file a motion requesting entry of the order. See § 1.637(a) and (b).

37 C.F.R. § 1.658:

. . . A judgment as to a count shall state whether or not each party is entitled to a patent containing the claims in the party's patent or application which correspond to the count. . . .

37 C.F.R. § 1.662(a) and (c):

(a) A party may, at any time during an interference, request and agree to entry of an adverse judgment. . . .

* * * *

(c) The filing of a statutory disclaimer under 35 U.S.C. 253 by a patentee will delete any statutorily disclaimed claims from being involved in the interference. A statutory disclaimer will not be treated as a request for entry of an adverse judgment against the patentee unless it results in the deletion of all patent claims corresponding to a count.

Treatise:

Rivise and Caeser *Interference Law and Practice,* (1947) Vol II, § 317, p. 1273:

> An interference may be terminated by dissolution on one or more of the following grounds:
>
> * * * *
>
> (3) In an interference involving an application and a patent, that the patentee has eliminated the conflicting subject matter by means of a reissue *or statutory disclaimer.*

Rivise and Caeser *Interference Law and Practice,* (1947) Vol. II, § 334, p. 1333:

> We have seen that a patentee involved in an interference may bring about a dissolution of the interference by filing a statutory disclaimer eliminating or substantially modifying the claims of his patent corresponding to the issue of the interference. . . .
>
> * * * *
>
> As has been stated, a patentee, who wishes to terminate an interference by disclaimer, has his choice between a statutory disclaimer and a disclaimer under Rule 107. *A statutory disclaimer is preferable, as it may result in a dissolution of the interference rather than in an adverse judgment.* [Emphasis added.]

STATEMENT OF THE CASE

This case involves Interference No. 103,096 declared by the Commissioner of Patents and Trademarks (Commissioner) pursuant to 35 U.S.C. § 135(a) between Guinn patent 4,889,812 (the '812 patent) and two pending applications of Kopf. The Commissioner summarily determined as a prerequisite to the redeclaration of Interference No. 103,096 that only claim 9 of the Guinn patent and thirty "corresponding" claims pending in the Kopf applications—albeit not identical to Guinn claim 9—are nevertheless for the "same patentable invention"—i.e., that each of the thirty Kopf application claims are limited to subject matter which would be "obvious", 35 U.S.C. § 103, and hence not patentable if Guinn's claim 9 were prior art. See 37 C.F.R. § 1.601(n).

Guinn filed a statutory disclaimer under 35 U.S.C. § 253 of his '812 patent claim 9—the only patent claim involved in the interference. The Board, instructed by 37 C.F.R. § 1.662(c), treated the Guinn disclaimer as a "request for entry of judgment". 37 C.F.R. § 1.658 required the judgment to state whether Kopf "is entitled to a patent containing the [30] claims in [Kopf's] applications which correspond to [but are not identical to Guinn claim 9]." The judgment entered by the Board states:

> For the foregoing reasons, judgment as to the subject matter of the sole count in issue is hereby awarded to Henry B. Kopf, the junior party.
>
> Accordingly, Henry B. Kopf is entitled to a patent containing his involved claims 19-31 in application Serial No. 07/442,240, and is also entitled to a patent containing his involved claims 20-38 in application Serial No. 07/207,655. . . . Perry W. Guinn, Gary N. Mills, Robert A. Bedient and Martin O Greeley, the senior party patentees, are not entitled to a patent containing their involved claim 9 which has been disclaimed under 35 U.S.C. 253. [App. 13a-14a]

The Court of Appeals affirmed "the Board's judgment" (App. 8a).

This case fundamentally challenges the Commissioner's scheme, spawned in 1984, to require that all interferences must be terminated only by a judgment—and not by dissolution or dismissal without a judgment. The validity of 37 C.F.R. § 1.662(c) and 37 C.F.R. § 1.658(a) which implement that scheme and which underpin both judgments is specifically challenged. Also challenged is the exercise of purported "jurisdiction" in the Board and the Court of Appeals to enter any priority "judgment" *after* all priority questions had been mooted by a statutory disclaimer under 35 U.S.C. § 253. Further challenged is the Board's power to enter any patentability "judgment" in favor of Kopf or any applicant party to an

interference in the absence of any patentability record developed before it to support such a "judgment".

I. EVOLUTION OF 37 C.F.R. §§ 1.662(c) AND 1.658(a)

35 U.S.C. § 135(a), in the 1952 Patent Act, limits the Board's jurisdiction to the determination of *only* "the question of priority" in an interference:

> (a) Whenever an application is made for a patent, which in the opinion of the Commissioner, would interfere with any pending application, or *with any unexpired patent,* he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. *The question of priority of invention shall be determined by a board of patent interferences.* . . . [emphasis added]

Under the 1952 Act, interferences involving an application and a patent were routinely *dissolved without a judgment* if the patentee filed a statutory disclaimer pursuant to 35 U.S.C. § 253 (1952) of the involved patent claim (count). This dissolution by disclaimer and without a judgment practice is set forth in the authoritative treatise Rivise and Caeser *Interference Law and Practice,* Vol. II, § 317:

> An interference may be terminated by dissolution on one or more of the following grounds:
>
> * * * *
>
> (3) In an interference involving an application and a patent, that the patentee has eliminated the conflicting subject matter by means of a reissue *or statutory disclaimer.*

and § 334:

> We have seen that a patentee involved in an interference may bring about a dissolution of the interference *by filing a statutory disclaimer eliminating* or substantially modifying the claims of his patent corresponding to the issue of the interference. . . .
>
> * * * *

> As has been stated, a patentee, who wishes to terminate an interference by disclaimer, has his choice between a statutory disclaimer and a disclaimer under Rule 107. *A statutory disclaimer is preferable, as it may result in a dissolution of the interference rather than in an adverse judgment.* [Emphasis added.]

In 1984, 35 U.S.C. § 135(a) was amended to supplement the Board's *mandatory* jurisdiction to determine the question of *priority* by adding *discretionary jurisdiction* to determine "questions of *patentability*".[1]

Section 135(a), as amended, states:

> (a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the Commissioner shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and MAY *determine questions of patentability*. . . . [emphasis added]

After the amendment, the Commissioner promulgated Rules 1.662(c) and 1.658, purportedly under 35 U.S.C. § 6, to *eliminate* the disclaimer-dissolution without a judgment practice routine under the 1952 Act.

37 C.F.R. § 1.662(c) provides:

> (c) The filing of a statutory disclaimer under 35 U.S.C. § 253 by a patentee will delete any statutorily disclaimed claims from being involved in the *interference. A statutory disclaimer will* NOT *be treated as a request for entry of an adverse judgment*

---

[1] This careful Congressional limitation to *discretionary* patentability determination accommodates situations where, *as here*, there is *no* record developed before the Board to support any informed patentability determination.

> *against the patentee* UNLESS *it results in the deletion of all patent claims corresponding to a count.* [emphasis added [2]]

37 C.F.R. § 1.658(a) requires that:

> *A judgment as to a count shall state whether or not claims in the party's patent or application which correspond to [i.e., are summarily said by the Commissioner to be for the "same patentable invention as"] the count.* [emphasis added; see 37 C.F.R. § 1.601(f)]

In this case the Board, deprived by 37 C.F.R. § 1.658 of its statutory *discretion* under 35 U.S.C. § 135(b) *not* to so do, entered a void judgment in the total absence of any supporting relevant record that Kopf is entitled to patents containing all of his thirty "correspond[ing]" claims.

II. PROCEEDINGS BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Guinn's counsel was cognizant of both the established pre-1984 dissolution by "disclaimer and without a judgment" practice under the 1952 Act *and* of the Commissioner's attempt by promulgation of 37 C.F.R. §§ 1.662(c) and 1.658 to abolish that practice. Because these rules seemed invalid, Guinn concurrently filed a statutory disclaimer under 35 U.S.C. § 253 of claim 9 which states: "This disclaimer is not a request for entry of an adverse judgment under 37 C.F.R. § 1.662" and a motion pursuant to 37 C.F.R. § 1.635 to dismiss the interference for lack of jurisdiction to determine priority. Guinn reasoned that the Board's "priority" jurisdiction was extinguished by the disclaimer which deleted the only involved patent claim 9 from the interference, i.e., there was no longer any question of priority for the Board to determine.

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[2] Rule 1.662(c) appears to be an oxymoron. Its second sentence requires entry of a priority judgment as to the same claim which the first sentence of the rule says is "deleted . . . from being involved in the interference" by the disclaimer.

Instead of deciding the motion to dismiss, the Board ordered Guinn, in view of the statutory disclaimer of his patent claim 9, to "show cause" why judgment should not be entered against him as required by 37 C.F.R. §§ 1.662(c) and 1.658.

To discharge the show cause order, Guinn reasserted the reasons stated in support of the motion to dismiss.

The Board's final decision states:

> under the new rules, all interferences are required to be terminated with a judgment rather than merely being dissolved. 49 Fed. Reg. 48416, *supra*, at 48419.
>
> We are bound by the rules of practice and, in particular, § 1.662(c). *Cf. Myers v. Feigelman*, 455 F.2d 596, 172 USPQ 580 (CCPA 1972). There is no question that the rule requires entry of judgment against Guinn here in view of the filing of a statutory disclaimer of Guinn's sole involved claim.

III. PROCEEDINGS BEFORE THE COURT OF APPEALS

Guinn argued below, as he had before the Board, that the jurisdiction of the Board under 35 U.S.C. § 135(a) to determine "priority" was extinguished because claim 9, the sole count, was *deleted* from the interference by Guinn's statutory disclaimer *before* the judgment was entered. Accordingly, there was no "application which would interfere . . . with an unexpired patent", 35 U.S.C. § 135(a), because there was no question of "priority . . . between two or more parties claiming the same patentable invention" as required by 37 C.F.R. § 1.601(i) for the Board to determine. Guinn also urged that the Board's discretion under 35 U.S.C. § 135(a) to determine any question of patentability as to any of Kopf's thirty involved claims could not be exercised for want of any patentability record developed before it.

To demonstrate invalidity of 37 C.F.R. § 1.662(c) under 35 U.S.C. § 6, Guinn's brief demonstrated that 37 C.F.R. § 1662(c) imposes on 35 U.S.C. § 253 a "requirement for entry of judgment" limitation which Congress did not include.

IV. THE FEDERAL CIRCUIT DECISION

To find that the Board had subject matter jurisdiction to determine priority notwithstanding the disclaimer, the Federal Circuit opinion says that

> The language of the statute itself militates against the interpretation that disclaiming all claims relating to a single count in an interference divests the Board of jurisdiction over an interference. Section 135 provides the basis for the Commissioner to declare an interference. Guinn does not dispute that Interference 103,096 was properly declared by the Commissioner. Section 135 also states that the Board "shall determine questions of priority" after the declaration of an interference. Guinn asserts that his unilateral act of disclaiming claim 9 of the '812 patent can divest the Board of its responsibility to determine the priority question in the interference. The statute does not provide for any such divestment of jurisdiction.
>
> We have previously stated that priority issues that have been fully developed before the Board should be resolved by the Board [quoting *Perkins v. Kwon*, 886 F.2d at 328-29 [3]]. [6a]

To hold that Rule 1.662(c) is *not in*valid because it does *not* "place[] a qualification that is not within the purview of 35 U.S.C. § 253 on the *right of a patentee to*

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[3] *Perkins* is not relevant because no "priority issues [had] been fully developed before the Board." Instead, all priority issues were mooted by the disclaimer.

statutorily disclaim subject matter" [4] (7a; emphasis added), the opinion states:

> Rule 1.662(c) as promulgated by the Commissioner simply allows the Board to dispose of an interference as to the patentee who disclaims all claims involved in an interference.

REASONS WHY THE WRIT SHOULD BE GRANTED

The Court of Appeals for the Federal Circuit has held that 37 C.F.R. § 1.662(c) is *not invalid* under 35 U.S.C. § 6 because it is "consistent with [Guinn's] right to disclaim under . . . 35 U.S.C. § 253" (8a). That ruling is simply wrong. It is contradicted by a mere reading of the Patent Office rule and the statute. This surprising Federal Circuit decision is the more egregious because Rule 1.662(c), as applied, has resulted in a frivolous "judgment" by the Board and affirmed below

(1) that a *patentee* party to an interference is not entitled to a patent containing a claim which was deleted from the interference by statutory disclaimer *before* the *"judgment"* was entered (see Question 2), and

(2) that a patent *applicant* party to an interference, even if no patentability issues have been developed on the interference record, is entitled to a patent containing a plurality of involved claims which are not identical to the claim which was disclaimed by the patentee (see Question 3).

For more than a decade before the 1952 Patent Act, interferences between an unexpired patent and a pending

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[4] To the contrary, § 253 does *not* provide a patentee a right "to disclaim *subject matter*"—§ 253 authorizes disclaimer only of "any complete claim" of a patent.

This escalation of § 253 by the court is the predicate for its several further attempts elsewhere in the opinion to escalate Guinn's "disclaimer of all claims involved in the interference"—i.e., not only of claim 9, but also of the thirty "involved" claims in Kopf's applications. *See* note 5, *infra*, p. 13.

application were terminated by dissolution and of necessity without a judgment upon patentee's disclaimer under 35 U.S.C. § 253 of all of the involved patent claims, which mooted all priority issues leaving nothing for the Board to adjudicate.

The Commissioner of Patents and Trademarks disfavored this practice. In 1984, the Commissioner promulgated new rules, in particular 37 C.F.R. § 1.662(c) and § 1.658, to abolish it. It was the intent of those rules, and they have been so applied in this case, to preclude any termination of an interference without a judgment. Instead, all interferences *must* be terminated *only* by a judgment.

The Federal Circuit strains to sustain Rule 1.662(c) in the face of its manifest clash with a patentee's unqualified statutory right under 35 U.S.C. § 253 to disclaim a specific claim from an issued patent. The flawed centerpiece of the Court's opinion is an unacknowledged and undocumented, but frequently repeated, implication that Guinn, by exercising his statutory right to disclaim his patent claim 9, *also* "disclaimed" 30 claims—all different from Guinn's patent claim 9—pending in two Kopf's patent applications.[5]

The Court's decision is wrong and its judgment is void virtually on its face and for all of the reasons now set

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[5] For example, at the threshold of its opinion, the Court refers to Guinn's "two attacks" on "the validity of Rule 1.662(c) as it concerns an entry of adverse judgment against a patentee who disclaims all claims corresponding to a count in an interference" (4a). This statement mischaracterizes the record. Without so stating, the Court's expression "all claims" includes and is intended to include *not only* Guinn's patent claim 9, which was disclaimed, *but also* Kopf's 30 "corresponding" claims. Contrary to the Board's statement, Guinn's statutory disclaimer was necessarily limited to his patent *claim 9, alone.* It did *not* and indeed could not extend to claims *only* in Kopf's applications, none of which are identical to Guinn's claim 9.

forth, which compel an affirmative answer to Question 1 and negative answers to Questions 2 and 3.

Guinn's brief below demonstrates:

> that 37 C.F.R. § 1.662(c) is "inconsistent with law", 35 U.S.C. § 6, because it
>
> > imposes a *limitation* upon 35 U.S.C. § 253 as evidenced by the following reproduction of that statute with the imposed limitation italicized:
> >
> > > . . . A patentee . . . may, on payment of the fee required by law, make disclaimer of any complete claim, . . . [*provided, however, if the patentee is involved in an interference, the disclaimer shall constitute a request for adverse judgment if it results in the deletion of all patent claims corresponding to the count*].
> >
> > Congress included no such limitation on 35 U.S.C. § 253 and, by 35 U.S.C. § 6, precluded the Commissioner from doing so by rule. [pp. 17-18]

The Federal Circuit's opinion ignores this demonstration that Rule 1.662(c) is invalid, with concomitant disregard of this Court's admonition that:

"*We have . . . cautioned that courts 'should not read into the patent laws limitations and conditions which the legislature has not expressed.' United States v. Dubilier Condenser Corp.*, 289 U.S. 178, 199, 53 S.Ct. 554, 561, 77 L.Ed. 1114 (1933)." [Emphasis added.] *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 100 S.Ct. 2204, 2207 (1980).

The opinion's feeble rejoinder (taken from the Commissioner's *amicus* brief) that "Rule 1.662(c) as promulgated by the Commissioner *simply allows* the Board to dispose of an interference as to the patentee who disclaims *all claims* involved in an interference" (emphasis added) (7a) is clearly wrong. It is contradicted by the fact, among others, that Rule 1.662(c) imposes limita-

tions on the disclaimer statute which are not acknowledged by the Court's statement.

In the statement quoted from the opinion, the expression "all claims involved in an interference" (7a) means not only such claims as may have been specifically disclaimed under 35 U.S.C. § 253 from a patentee's own patent, but "all claims" of an adverse party's application which are different from but nevertheless designated by the Commissioner to "correspond" to the patentee's disclaimed claim. See note 5, *supra*. In the context of this interference, the expression "all claims" means not only Guinn's patent claim 9, as to which his statutory right to disclaim was specifically exercised, but also Kopf's 30 "corresponding" application claims, all of which are different from Guinn's claim 9. This Court's statement is not relevant to this interference because Guinn did not disclaim "all claims"—but only claim 9 of his patent.

Citing *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U.S. 477, 492 (1935), the opinion states that "by filing a statutory disclaimer, Guinn relinquished any right to exclude others from the subject matter of claim 9" (7a). Contrary to the inference which this statement may invite, however, Guinn did *not* by filing the disclaimer relinquish any right whatever with respect to the "subject matter" of any of Kopf's 30 pending claims which are different from claim 9.

The Court's opinion goes on to state: "Rule 1.662(c) clearly calls for entry of judgment only *against the patentee* who disclaimed the involved claims, and through his own admission is not entitled to the disclaimed claim, and nothing more" (7a-8a) (emphasis in original). This statement is incorrect for several reasons:

(1) Guinn did not disclaim the 30 Kopf claims "involved" in the interference, but only and specifically claim 9 of his patent "and nothing more".

(2) The judgment amended by 37 C.F.R. § 1662(c) must comply with § 1.658 and, therefore, include a determination of whether Kopf is entitled to a patent containing his 30 corresponding claims which are different from Guinn's cancelled claim 9.

Thus, the statement that the judgment is "only *against the patentee*" (8a; emphasis in original) tends to create an erroneous impression that Guinn suffered no adverse consequences from the entry of the judgment beyond those consequent from the disclaimer. To the contrary, however, Guinn and the public must now await the grant to Kopf of a patent which contains the 30 "involved" application claims—all in derogation of "the PTO's mission to grant presumptively valid patents. 35 U.S.C. § 285 . . .". *Perkins*, 886 F.2d at 328-9.

The opinion then states:

> Rule 1.662(c) does not address the question of the patentability of a claim or claims corresponding to a count to the party or parties of the interference who have not so disclaimed all of the involved claims. (8a)

This statement is also incorrect, however, because the "judgment", entry of which Rule 1.662(c) mandates, must include a determination of the question of patentability of the "claim or claims corresponding to a count which the party or parties of the interference . . . have not so disclaimed"—here Kopf's 30 application claims (8a). And again the implication that Guinn disclaimed "all of the involved claims" (8a) is simply wrong for reasons stated above.

Based on these erroneous premises, the opinion states: "Therefore, the entry of a judgment against Guinn in the interference is proper and consistent with his right to disclaim under 35 U.S.C. § 253" (8a)—i.e., that Rule 1.662(c) is "not inconsistent with § 253". This ruling is wrong because the premises upon which it is based have

been shown to be wrong. In particular, Guinn's "right to disclaim under 35 U.S.C. § 253" is *un*qualified. It is not conditioned upon an implied "disclaimer" of Kopf's 30 involved application claims.

Finally, the opinion states that: "The patentability of Kopf's claims corresponding to the count is beyond the scope of this appeal" (8a). Actually, this statement is just a cover up for the Court's evasion of its obligation to adjudicate the key question which *was* squarely presented by the appeal, namely, whether—for lack of any patentability record developed before it—so much of the judgment as states that Kopf is entitled to a patent containing the 30 corresponding claims is void. Indeed, the very fact that the patentability of Kopf's 30 claims was "beyond the scope of this appeal" (8a) is the direct consequence of the lack of any patentability record and therefore of any determination of any patentability question by the Board.

CONCLUSION

The incorrect decision of the Federal Circuit will control the practice in every interference now pending or later declared between an unexpired patent and a pending application. There is no possibility that the matter will be further reviewed by the Court of Appeals because the panel decision was maintained on reconsideration. Grant of this Petition is essentially to rectify the interference procedures in the Patent Office.

Respectfully submitted,

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APPENDICES

APPENDICES

APPENDIX A

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

96-1098
(Interference No. 103,096)

PERRY W. GUINN, GARY N. MILLS, ROBERT A. BEDIENT and MARTIN O. GREELEY,
Appellants,

v.

HENRY B. KOPF,
Appellee.

Appealed from Trademark Office
Board of Patent Appeals and Interferences

DECIDED: September 26, 1996

Before RICH, NEWMAN, and BRYSON, *Circuit Judges.*

RICH, *Circuit Judge.*

Perry W. Guinn, Gary N. Mills, Robert A. Bedient, and Martin O. Greeley (collectively Guinn) appeal the judgment of the Board of Patent Appeals and Interferences (Board) mailed on November 29, 1994 in Patent Interference No. 103,096, wherein the sole count in issue in the interference was awarded to appellee Kopf, and the Board held that Kopf was entitled to a patent containing claims 19-31 in application Serial No. 07/442,240, and

a patent containing claims 20-38 in application Serial No. 07/207,655, with the proviso that Kopf avoid a double patenting rejection upon resumption of prosecution upon termination of the interference.[1] We have jurisdiction under 38 [sic 28] U.S.C. § /1295(a)(4)(A) (1994) and 35 U.S.C. § 141 (1994) to review this appeal from the final decision of the Board. We affirm.

Background

On September 29, 1994, Interference No. 103,096 was redeclared by the United States Patent and Trademark Office (PTO) between United States Patent No. 4,889,812 ('812 patent) issued to Guinn and two patent applications of Kopf with Serial Nos. 07/442,240 ('240 patent application) and 07/207,655 ('655 patent application). The redeclared interference contained a single count corresponding to claim 9 of the '812 patent, claims 19-31 of the '240 patent application, and claims 20-38 of the '655 patent application.

On October 13, 1994, Guinn attempted to terminate the interference by filing a statutory disclaimer under 35 U.S.C. § 253 of claim 9, the only claim of the '812 patent corresponding to the single count of the interference, and a concurrent motion pursuant to 37 C.F.R. § 1.635 to dismiss the interference for lack of jurisdiction. Guinn asserted that as a result of the disclaimer of claim 9, no claim which corresponded to the single count of the interference remained in the '812 patent so that no controversy existed between the parties. Therefore, Guinn reasoned that the Board had no jurisdiction to enter a judgment and should have dismissed the interference. To this end, Guinn specifically stated in the statutory dis-

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[1] Guinn also seeks to appeal the denial of a petition to the Commissioner pursuant to 37 C.F.R. § 1.644(a)(1) and (2). We need not determine whether we have jurisdiction over an appeal from the denial of such a petition because the same issues were presented to and decided by the Board.

claimer that: "This disclaimer is not a request for entry of an adverse judgment under 37 C.F.R. § 1.662."

In response to the motion to dismiss filed by Guinn, on November 1, 1994 the Board issued an order to show cause why judgment should not be entered against Guinn as a result of the statutory disclaimer. The Board stated that even though Guinn specifically asserted in his statutory disclaimer that it was not a request for entry of an adverse judgment, "[p]ursuant to 37 CFR 1.662(c), the statutory disclaimer will be treated as a request for entry of an adverse judgment against Guinn et al."

Guinn filed a response to the order to show cause reasserting the argument that 37 C.F.R. § 1.662(c) was invalid as a matter of law because the Board lacked jurisdiction to enter judgment against Guinn because Guinn was no longer "claiming the same patentable invention" as required by 35 U.S.C. § 135(a) with the advent of the disclaimer of claim 9 of the '812 patent. On November 14, 1994, Kopf filed a response to Guinn's response to the order to show cause asserting that the Commissioner had the authority under the broad jurisdiction over patent matters granted to him by Congress in 35 U.S.C. § 6 to promulgate 37 C.F.R. § 1.662(c). Kopf argued that by disclaiming under 35 U.S.C. § 253 the only claim involved in the interference, Guinn conceded that the invention was unpatentable to him and that adverse judgment was appropriate as called for by 37 C.F.R. § 1.662(c).

The Board issued its final decision on November 29, 1994 entering a judgment as to the sole count in issue in the interference to appellee Kopf, and awarding a patent containing claims 19-31 of the '240 patent application to Kopf, and a patent containing claims 20-38 of the '655 patent application to Kopf, with the proviso that Kopf avoid the double patenting rejection upon resumption of prosecution upon termination of the interference.

On December 9, 1994, Guinn filed a petition pursuant to 37 C.F.R. § 1.644(a)(1) and (2) requesting that the

judgment of the Board be vacated, that 37 C.F.R. § 1.662(c) be declared invalid and void because it is "inconsistent with law" and exceeds the power vested in the Commissioner under 35 U.S.C. §§ 6 and 7, and that the judgment be vacated because at the time it was entered, no actual controversy existed between the parties and the Board had no jurisdiction. Kopf responded by arguing again that the Commissioner properly promulgated 37 C.F.R. § 1.662(c) under 35 U.S.C. §§ 6 and 7 providing the Board with valid jurisdiction to enter adverse judgment against Guinn in the interference. On January 23, 1995 the Board denied the petition ruling that 37 C.F.R. § 1.662(c) is not inconsistent with 35 U.S.C. § 253 and was within the scope of the Commissioner's authority to establish regulations for the conduct of proceedings within the PTO under 35 U.S.C. § 6.

Discussion

The single issue we must decide is whether the Commissioner properly promulgated 37 C.F.R. § 1.662(c) (Rule 1.662(c)) under the authority granted by Congress under 35 U.S.C. § 6. Rule 1.662(c) provides:

> The filing of a statutory disclaimer under 35 U.S.C. 253 by a patentee will delete any statutorily disclaimed claims from being involved in the interference. *A statutory disclaimer will not be treated as a request for entry of an adverse judgment against the patentee unless it results in the deletion of all patent claims corresponding to a count.*

37 C.F.R. § 1.662(c) (1995) (emphasis added).

Appellant offers two attacks on the validity of Rule 1.662(c) as it concerns an entry of adverse judgment against a patentee who disclaims all claims corresponding to a count in an interference. First, Guinn asserts that the judgment entered by the Board against him pursuant to Rule 1.662(c) is void because Guinn's statutory dis-

claimer of the only claim involved in the interference count extinguished any subject matter jurisdiction of the Board under 35 U.S.C. § 135, and is thus a rule promulgated by the Commissioner that is inconsistent with law in contradiction to his authority under 35 U.S.C. § 6. Second, Guinn argues that Rule 1.662(c) is inconsistent with the law regarding statutory disclaimers, 35 U.S.C. § 253, because Rule 1.662(c) imposes a limitation on a patentee's right to disclaim that is not provided in 35 U.S.C. § 253. Both of these attacks on the validity of Rule 1.662(c) involve statutory interpretation only. Therefore, they are questions of law which we review de novo. *Astra* v. *Lehman*, 71 F.3d 1578, 1580, 37 USPQ2d 1212, 1214 (Fed. Cir. 1995).

I. *The Board's Subject Matter Jurisdiction*

Congress has provided that the Commissioner "may . . . establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office." 35 U.S.C. § 6(a)(1994). Congress has also provided that:

> Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the Commissioner shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability.

Pursuant to 35 U.S.C. §135, Interference 103,096 was redeclared. Appellant does not assert that such declaration was erroneous. Appellant asserts that because he availed himself of 35 U.S.C. § 253 to disclaim the only claim of his patent corresponding to the interference count, the interference should have been dismissed with

no adverse judgment against him because the Board had no jurisdiction over the interference as defined by 35 U.S.C. §135 to enter such an adverse judgment.

The language of the statute itself militates against the interpretation that disclaiming all claims relating to a single count in an interference divests the Board of jurisdiction over an interference. Section 135 provides the basis for the Commissioner to declare an interference. Guinn does not dispute that Interference 103,096 was properly declared by the Commissioner. Section 135 also states that the Board "shall determine questions of priority" after the declaration of an interference. Guinn asserts that his unilateral act of disclaiming claim 9 from the '812 patent can divest the Board of its responsibility to determine the priority question in the interference. The statute does not provide for any such divestment of jurisdiction.

We have previously stated that priority issues that have been fully developed before the Board should be resolved by the Board.

> The Board, by resolving both priority and patentability when these questions are fully presented, settles not only the rights between the parties, but also rights of concern to the public. The public interest in the benefits of a patent system is best met by procedures that resolve administratively questions affecting patent validity that arise before the PTO. To do otherwise is contrary to the PTO's mission to grant presumptively valid patents, 35 U.S.C. § 285, and thus disserves the public interest.

Perkins v. *Kwon*, 886 F.2d 325, 328-29, 12 USPQ2d 1308, 1311 (Fed. Cir. 1989).

We hold that the Board had the authority and the responsibility pursuant to 35 U.S.C. § 135(a) to resolve the interference and render judgment against Guinn as a result of his disclaimer of claim 9 of the '812 patent.

II. *Authority of the Commissioner under 35 U.S.C. § 6*

The second issue before us in the determination of whether Rule 1.662(c) is valid is whether the rule as promulgated by the Commissioner places a qualification that is not within the purview of 35 U.S.C. § 253 on the right of a patentee to statutorily disclaim subject matter. If such an unauthorized qualification is imposed by Rule 1.662(c), it is inconsistent with law and outside the authority granted to the Commissioner under 35 U.S.C. § 6.

To aid in the disposition of interferences, the Commissioner, pursuant to 35 U.S.C. § 6(a), promulgated 37 C.F.R. § 1.662(c). The right of a patentee to statutorily disclaim a claim or claims is provided in 35 U.S.C. § 253, which states that:

> A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent.

35 U.S.C. § 253 (1994).

A statutory disclaimer under 35 U.S.C. § 253 has the effect of canceling the claims from the patent and the patent is viewed as though the disclaimed claims had never existed in the patent. *See Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U.S. 477, 492 (1935) ("Upon the filing of the disclaimers, the original claims were withdrawn from the protection of the patent laws, and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned."). Therefore, by filing a statutory disclaimer, Guinn relinquished any right to exclude others from the subject matter of claim 9.

Rule 1.662(c) as promulgated by the Commissioner simply allows the Board to dispose of an interference as to the patentee who disclaims all claims involved in an interference. Rule 1.662(c) clearly calls for entry of

judgment only *against the patentee* who disclaimed the involved claims, and through his own admission is not entitled to the disclaimed claim, and nothing more. Rule 1.662(c) does not address the question of the patentability of a claim or claims corresponding to a count to the party or parties of the interference who have not so disclaimed all of the involved claims. Therefore, the entry of a judgment against Guinn in the interference is proper and consistent with his right to disclaim under 35 U.S.C. § 253. The patentability of Kopf's claims corresponding to the count is beyond the scope of this appeal. We hold that rule 1.662(c) as promulgated by the Commissioner under 35 U.S.C. § 6(a) is valid.

Conclusion

We affirm the Board's judgment of November 29, 1994 in Patent Interference No. 103,096, against Guinn.

AFFIRMED

APPENDIX B

[Mailed Nov. 29, 1994]
Paper No. 48

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

HENRY B. KOPF,
Junior Party [1]

v.

HENRY B. KOPF,
Junior Party [2]

v.

PERRY W. GUINN, GARY N. MILLS, ROBERT A. BEDIENT and MARTIN O. GREELEY,
Senior Party [3]

Patent Interference No. 103,096

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[1] Application of 07/442,240, filed November 28, 1989. Accorded the benefit of U.S. Application 06/936,486, filed November 26, 1986, now U.S. Patent No. 4,885,087, issued December 5, 1989.

[2] Application 07/207,655, filed June 21, 1988. Accorded the benefit of U.S. Application 06/936,486, filed November 26, 1986, now U.S. Patent No. 4,885,087, issued December 5, 1989.

[3] Patent 4,889,812, issued December 26, 1989, based on U.S. Application 06/862,014, filed May 12, 1986. Assignors to UniSyn Technologies, Inc.

Before SOFOCLEOUS, CAROFF and DOWNEY, *Administrative Patent Judges.*

CAROFF, *Administrative Patent Judge.*

FINAL DECISION

This interference involves two applications of the junior party, Kopf, and a patent of the senior party, Guinn et al (Guinn). According to the record before us, the Guinn patent is assigned to UniSyn Technologies, Inc. (Paper No. 4); whereas each of the two Kopf applications is unassigned.

The subject matter of the interference relates to an apparatus for circulating fluid through a shell and tube type bioreactor. This invention is particularly defined by the sole count[4] in issue which reads as follows:

Count 2

An apparatus for cultural microbial species, comprising:

a nutrient source;

a 4-way switchable valve comprising first, second, third and fourth fluid ports switchable between (i) a first position wherein the first and second fluid ports are in flow communication with one another, and the third and fourth fluid ports are in flow communication with one another, and (ii) a second position wherein the first and fourth fluid ports are in flow communication with one another, and the second and third fluid ports are in flow communication with one another;

a shell and tube type bioreactor having first and second ends communicating with bioreactor lumen tubes for flow of fluid medium therethrough; and

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[4] Original count 1 was canceled and count 2 added by redeclaration (Paper No. 32).

> flow circuit means interconnecting the nutrient source, the 4-way switchable valve, and the shell and tube type bioreactor, such that when the 4-way switchable valve is in the first position, the flow through the bioreactor lumen tubes is in a first flow direction, and when the 4-way switchable valve is in the second position, the flow through the bioreactor lumen tubes is in a second flow direction.

The claims of the parties which correspond to count 2 are:

Kopf (Serial No. 07/442,240):	Claims 19-31
Kopf (Serial No. 07/207,655):	Claims 20-38
Guinn et al.:	Claim 9

On October 13, 1994, Guinn filed a statutory disclaimer of its sole involved claim (claim 9). Accordingly, the Administrative Patent Judge (APJ) issued an order to show cause against Guinn (Paper No. 43), indicating that the statutory disclaimer will be treated as a request for entry of an adverse judgment against Guinn pursuant to 37 CFR 1.662(c). Guinn has filed a response to the order to show cause (Paper No. 45), and Kopf has filed a response to that of Guinn (Paper No. 46).

In their respective responses, neither party has requested that a final hearing or a testimony period be set with respect to the propriety of the show cause order. Rather, the Guinn response contains a discussion of reasons why Guinn believes that the rule, § 1.662(c), is "facially invalid" and that the Board therefore lacks jurisdiction to enter judgment against Guinn in view of Guinn's filing of a statutory disclaimer.

As set forth in the Commissioner's Notice entitled "*Interference Practice: Response to Order to Show Cause under 37 CFR 1.640,*" 1074 O.G. 4 (Jan. 6, 1987),

where the response does not request a final hearing or a testimony period but, instead, contains a full discussion of the reasons why judgment should not be entered, the response paper is deemed to waive "any opportunity to present oral argument concerning the matters discussed therein, and the matter will be decided by the Board based upon the content of the paper and any response thereto." *Qadri v. Chu*, 18 USPQ2d 1254 (BPAI 1990), *aff'd. mem.*, 965 F.2d 1063 (Fed. Cir. 1992); *Brown v. Bravet*, 25 USPQ2d 1147 (BPAI 1992). Accordingly, we will decide the matter discussed by the parties in their respective responses based upon the arguments presented therein.

We have carefully considered the papers filed in response to the order to show cause and find that entry of judgment against Guinn is appropriate essentially for the reasons presented by Kopf. Indeed, judgment is mandatory according to the commentary accompanying the adoption of the present interference rules as follows:

> Several comments discussing [§] 1.662 were received. Two comments suggested a change be made to provide that when a patentee files a statutory disclaimer under 35 U.S.C. 253 and deletes all claims corresponding to a count, the disclaimer will be treated as a request for judgment. As one of the comments pointed out, "[s]ince . . . [the filing of a statutory disclaimer disclaiming all claims corresponding to a count] by the patentee could have no other conceivable effect, the proposed rule should be changed to require judgment when all corresponding claims are disclaimed." The suggestion has been adopted and appropriate changes have been made to [§] 1.662(c).
>
> —49 Fed. Reg. 48416, 48447 (Dec. 12, 1984)

Further, under the new rules, all interferences are required to be terminated with a judgment rather than

merely being dissolved. 49 Fed. Reg. 48416, *supra*, at 48419.

We are bound by the rules of practice and, in particular, § 1.662(c). *Cf. Myers v. Feigelman*, 455 F.2d 596, 172 USPQ 580 (CCPA 1972). There is no question that the rule requires entry of judgment against Guinn here in view of the filing of a statutory disclaimer of Guinn's sole involved claim.

Guinn's argument relating to the authority of the Commissioner to promulgate § 1.662(c) and the validity of that rule is unsound. There is no question that this interference was properly declared, and that the Board thereby acquired jurisdiction over the interference. 37 CFR 1.614. Guinn has cited no authority to support its position which would in effect give a party the power to deprive the Board of jurisdiction, once acquired, by taking unilateral action. Indeed, it is well settled that a party may not avoid judgment as to claims corresponding to a count by, for example, amending or canceling those claims. *Cf.* Rivise and Caesar, *Interference Law and Practice*, Vol. II, Michie Co., 1947, § 317 (p. 1274), § 333 (pp. 1332-33).

Judgment [5]

For the foregoing reasons, judgment as to the subject matter of the sole count in issue is hereby awarded to Henry B. Kopf, the junior party.

Accordingly, Henry B. Kopf is entitled to a patent containing his involved claims 19-31 in application Serial

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[5] It is noted that Kopf filed a § 1.635 motion on Nov. 14, 1994 (Paper No. 47) requesting suspension of the testimony period set in Paper No. 33. The motion is unopposed and is considered to be moot in view of the judgment entered herein. However, in view of the possibility that Guinn may file an appeal or petition regarding our decision, the motion to suspend the previously set testimony and briefing period is *granted* pending the outcome of any such appeal or petition.

No. 07/442,240, and is also entitled to a patent containing his involved claims 20-38 in application Serial No. 07/207,655, provided that Kopf takes the action which is necessary to avoid a double patenting rejection, *e.g.*, by filing a terminal disclaimer in one of his involved applications, when *ex parte* prosecution resumes upon termination of this interference. Perry W. Guinn, Gary N. Mills, Robert A. Bedient and Martin O. Greeley, the senior party patentees, are not entitled to a patent containing their involved claim 9 which has been disclaimed under 35 U.S.C. 253.

BOARD OF PATENT APPEALS
AND INTERFERENCES

/s/ Michael Sofocleous
MICHAEL SOFOCLEOUS
Administrative Patent Judge

/s/ Marc L. Caroff
MARC L. CAROFF
Administrative Patent Judge

/s/ Mary F. Downey
MARY F. DOWNEY
Administrative Patent Judge

APPENDIX C

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

96-1098
(Interference No. 103,096)

PERRY W. GUINN, GARY N. MILLS,
ROBERT A. BEDIENT and MARTIN O. GREELEY,
Appellants,

v.

HENRY B. KOPF,
Appellee.

ORDER

A combined petition for rehearing and suggestion for rehearing in banc having been filed by the APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing in banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, DECLINED.

The mandate of the court will issue on November 19, 1996.

FOR THE COURT,
MELVIN L. HALPERN
Acting Clerk

Dated: November 12, 1996

By /s/ Brian P. LeDuc
BRIAN P. LEDUC
Associate Chief Deputy Clerk